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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,222	03/12/2004	Dennis Scott Wolever	88265-7735	8552

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WINSTON & STRAWN LLP
PATENT DEPARTMENT
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WASHINGTON, DC 20006

EXAMINER

STULII, VERA

ART UNIT	PAPER NUMBER
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1761

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/800,222

Applicant(s)

WOLEVER ET AL.

Examiner

Vera Stulii

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/12/04, 10/21/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-28, drawn to an edible fat-based shell and method of making, classified in class 426, subclass 090.
- II. Claims 29-33, drawn to an apparatus for producing fat-based shell, classified in class 118, subclass 13.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process.

During a telephone conversation with Allan A. Fanucci on March 13, 2007 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1, 14-19, 24, and 27-28 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 14-18, 21, and 25-26 of copending Application No. 10/984914.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-13, 20-23, and 25-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-5, 7, 19-20, and 23-24 of copending Application No. 10/984914. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim and edible fat-based shell comprising packaging support and wall formed directly on a packaging support, where fat-based composition comprises common emulsifiers, sugars, and fat.

Both applications claim a method of making an edible fat-based shell by directly showering or pouring an edible –shell forming composition on the packaging support.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

Claim 22 that recites sweeteners should be renumbered as claim 23. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 2-4, it is noted that filling is not a part of the shell.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard et al (WO 0215706) in view of Kaiser et al (US 6391373).

In regard to claims 1-14, Pritchard et al disclose an edible fat-based shell, a packaging support having desired shape (cone or cup shape) that defines a volume and a wall that is formed directly on a packaging support from an amount of an edible shell forming composition comprising one or more fats (Abstract).

In regard to claims 2 and 10, Pritchard et al disclose that the walls have a shape of a cup or a cone (Abstract). Pritchard et al also disclose filling that is retained within a shell (Abstract).

In regard to claims 3 and 5, Pritchard et al disclose that "the filling may extend beside the length of the shell" (P. 4 line 16).

In regard to claim 4, Pritchard et al disclose that the filling is an ice confectionery (Abstract).

In regard to claim 5, Pritchard et al also disclose ice-cream, sorbet or water ice as a filling (p.9 line 35, p. 10 line 5).

In regard to claim 8, Pritchard et al disclose sugar solids.

In regard to claim 11, Pritchard et al disclose that "the packaging sheet, the dies and the shell are each substantially in the same shape" (p. 4lines 4-5). Pritchard et al

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also disclose that "it can be a cup, preferably representing the shape of a flower cup of corolla, with a curved side wall of convex, concave or convex-concave shape" (p. 4 lines 12-14).

In regard to claims 12 and 13, Pritchard et al disclose that "the solid composition may further contain inclusions of sugar confectionery, such as gels, marshmallow, fudge or pieces of preserved fruit, nuts, toasted, puffed or roasted cereal or biscuit crumbs" (p.4 lines 33-35).

In regard to claim 14, Pritchard et al disclose that "packaging sheet may be made from a laminate material, paper, cardboard or plastic (p. 5 lines 9-10, 14-15).

Pritchard et al do not disclose thickness consistency, plastic viscosity, and a yield value of the edible shell, use of emulsifier, and particular amounts of fat, emulsifier and sweetener.

In regard to claim 1, Kaiser et al disclose fat-based chocolate composition having good rheological characteristics, i.e. is suitable for processing in enrobing, extruding or moulding operations (Col. 9 lines 28-33). Kaiser et al disclose, that to be suitable for such operations the chocolate compositions may have a plastic viscosity less than about 80 poise and yield value less than about 200 dynes/cm².

In regard to claim 6 and 7, Kaiser et al disclose use of emulsifier such as polyglycerol polyricinoleate, ammonium phosphatides and soy lecithin (Col. 8 lines 62-68). Kaiser et al disclose that "[a]dvantageously, the emulsifier combinations of polyglycerol polyricinoleate, sucrose polyerucate, ammonium phosphatides and soy lecithin, offer significant improvement in the rheology of the chocolates of the present

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invention, and particularly of the reduced-fat chocolates of the present invention" (Col. 8 lines 62-68). Kaiser et al disclose using emulsifier in an amount of no more than 1% by weight of the composition and a sweetener (Col. 22-23 Example 2).

In regard to claim 9, Kaiser et al disclose "the confectioneries of this invention having a total fat content of about 16% to about 35% by weight and with desirable rheology characteristics" (Col. 1 lines 17-22). Kaiser et al disclose fat-based composition having 20.3 total fat, 66.4% sucrose and 0.5% lecithin (Col. 22-23 Example 2).

Since Pritchard et al disclose a wall that is formed directly on a packaging support from an amount of an edible shell forming composition comprising one or more fats, and Kaiser et al disclose fat-based chocolate composition having good rheological characteristics, i.e. is suitable for processing in enrobing, extruding or moulding operations having a plastic viscosity less than about 80 poise and yield value less than about 200 dynes/cm² comprising fat, emulsifier and sweetener, it would have been obvious to one of the ordinary skill in the art to modify disclosure of Pritchard et al and employ fat-based composition disclosed by Kaiser et al in order to achieve desired rheological characteristics such as viscosity, structure and flow properties to successfully apply fat-based composition on the packaging support with desired thickness consistency.

Claims 15-19, 21-24, and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter et al (GB 1,017,480) in view of Kaiser et al (US 6391373).

Carter et al disclose the manufacture of novelty frozen desert product that combine ice-cream with chocolate wrapped in paper container or jackets (p.1 lines 11-17). In regard to claims 15-28, Carter et al disclose "a method of manufacturing a novelty frozen dessert product including the steps of coating the inside surface of a thin walled container substantially impervious to the coating with an edible coating material, said material having a hardening point and being in a liquefied state at a temperature above the hardening point and placing the frozen dessert in a fluid state in the container in direct contact with the coating" (p. 1 lines 71-84, p. 3 claim 3). Thus Carter et al discloses a method for producing an edible fat-based shell by directly showering or pouring an edible shell-forming composition on the packaging support.

In regard to claim 17 and 24, Carter et al disclose the method of manufacturing frozen desert product where the walls have the shape of a cone and which further comprises providing a filling that is at least partially retained within the shell (Fig. 14).

In regard to claim 18, Carter et al disclose that confectionery completely fills the shell (Fig. 14).

In regard to claim 19, Carter et al disclose that filling comprises and ice confection (p.1 lines 11-17).

In regard to claim 27, Carter et al disclose paper container or jackets (p.1 line 17).

In regard to claim 28, Carter et al disclose plurality of streams (Fig. 11).

Carter et al do not disclose thickness consistency, plastic viscosity, and a yield value of the edible shell, use of emulsifier and sweetener.

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Kaiser et al is taken as cited above.

Since Carter et al discloses a method for producing an edible fat-based shell by directly showering or pouring an edible shell-forming composition on the packaging support, and Kaiser et al disclose fat-based chocolate composition having good rheological characteristics, i.e. is suitable for processing in enrobing, extruding or moulding operations having a plastic viscosity less than about 80 poise and yield value less than about 200 dynes/cm² comprising fat, emulsifier and sweetener, it would have been obvious to one of the ordinary skill in the art to modify disclosure of Carter et al and employ fat-based composition of Kaiser et al in order to achieve desired rheological characteristics such as viscosity, structure and flow properties to successfully apply fat-based composition on the packaging support with desired thickness consistency.

Claims 20 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter et al (GB 1,017,480) in view of Kaiser et al (US 6391373) as applied to claims 15-19, 21-24, and 27-28 above, and further in view of Pritchard et al (WO 0215706).

Carter et al, Kaiser et al, and Pritchard et al (WO 0215706) are taken as cited above.

Carter et al and Kaiser et al do not disclose that ice-cream extends beyond the open top of the receptacle so as to be provided as an exposed mass for easy consumption, the shell is formed with a crenelated top rim and inclusions on an inner surface of the shell.

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Pritchard et al disclose that "the filling may extend beside the length of the shell" (P. 4 line 16). Pritchard et al disclose that "the packaging sheet, the dies and the shell are each substantially in the same shape" (p. 4 lines 4-5). Pritchard et al also disclose that "it can be a cup, preferably representing the shape of a flower cup of corolla, with a curved side wall of convex, concave or convex-concave shape" (p. 4 lines 12-14). Pritchard et al disclose that "the solid composition may further contain inclusions of sugar confectionery, such as gels, marshmallow, fudge or pieces of preserved fruit, nuts, toasted, puffed or roasted cereal or biscuit crumbs (p.4 lines 33-35).

Since Carter et al discloses a method for producing an edible fat-based shell by directly showering or pouring an edible shell-forming composition on the packaging support, and Kaiser et al disclose fat-based chocolate composition having good rheological characteristics, and Pritchard et al disclose a wall that is formed directly on a packaging support from an amount of an edible shell forming composition comprising one or more fats, it would have been obvious to modify disclosures of Carter et al and Kaiser et al and to extend the ice-cream beyond the open top of the receptacle, and to form the shell with a crenelated top rim and inclusions on an inner surface of the shell in order to provide ice-cream confectionery product having more appealing appearance that is suitable for forming a product that resembles a flower shape and having improved taste as taught by Pritchard et al.

Conclusion

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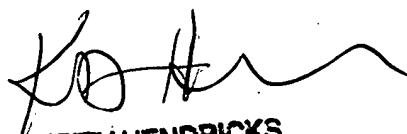
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Stulii whose telephone number is (571) 272-3221.

The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vera Stulii



KEITH HENDRICKS
PRIMARY EXAMINER